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In re application of :
Werner Temme et al. : DECISION ON
Serial No. 09/768,274 : PETITION
Filed: January 25, 2001 :
For: USE OF AQUEOUS POLYURETHANE DISPERSIONS IN :
FORMULATIONS FOR SPORTS FLOOR COVERINGS :

This is a decision on the REQUEST FOR RESETTING OF TIME FOR RESPONSE, filed May 10, 2004. At the time of the filing of the present request, the present application was under Final rejection based on the Final Office action mailed on April 9, 2003. Applicant filed a response to the Final rejection under 37 CFR 1.116 on July 8, 2003. Upon not receiving a communication in reply to the response filed on July 8, 2003, the applicant filed a Notice of Appeal on October 9, 2003, along with a Petition of a Three-month extension of time. On May 10, 2004, after still not receiving a communication in reply to the response filed on July 8, 2003, the applicant filed a Request for Continued Examination, a Petition of a Five-month extension of time, and the present request for resetting of time for response. The Applicants request that the time for consideration in this application be reset based on the Patent Office's error of not entering the previous timely filed response into the file for consideration by the examiner. Additionally, if the time for consideration is reset, Applicants hereby request withdrawal of the Request for Continued Examination and Extension of Time, as well as the previously filed Notice of Appeal and Extension of Time, and a refund of all fees paid.

DECISION

A review of the requestor's evidence provided with the instant request indicates that the request does not have merit. Although the evidence submitted, confirms that applicants' did not receive a response to their After Final submission, this evidence does not warrant resetting the statutory period of response set forth in the Final Rejection.

The Final rejection of April 9, 2003 clearly stated that "A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action."

37 C.F.R. 1.116 (b) states:

"§ 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. **The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing**

prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section." (emphasis added)

37 CFR 1.113 states:

"§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, **whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116.** Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). **Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section.** For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form." (Emphasis added)

37 CFR 1.114 states:

"§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
- (4) An application for a design patent; or
- (5) A patent under reexamination.

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000]"

Whether or not applicants' received a reply to the July 8, 2003 response, which was filed three months from the Final rejection mailing, from the USPTO, given the finality of the rejection in the instant application, the only courses of action available to the applicant as the end of the 6-month statutory period approached, given the above rules, would have been:

- (1) To file an amendment, and ensure that it was matched with the file and considered by the Examiner, with the proper extension of time fee, under 37 C.F.R. 1.116, which placed the application in condition for allowance, see MPEP 706.07(f);
- (2) File a notice of appeal with the proper extension of time fee, see MPEP 1205;
- (3) File a continuing application under 37 C.F.R. 1.53(b) or (d), see MPEP 201.06(c) and (d),
- (4) File a request for continued examination under 37 C.F.R. 1.114, or;
- (5) Abandon the application.

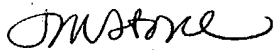
While the Office attempts to promptly match with the application file and respond to an amendment after final, there are those instances where delays do occur, as in the instant application. However, it is clear from 37 C.F.R. 1.116 that abandonment of an application is risked when an amendment after a final Office action is proffered by the applicant. The rule clearly indicates that the mere filing of an amendment does not relieve the applicant of the duty of taking appropriate action to save the application from abandonment. Therefore, whether the requestor's reply was received and matched with the instant application file or not prior to the expiration of the six-month statutory period, the only right the requestor was entitled to was that of appealing the final rejection or by filing a continuing application or request for continued examination.

Thus, the requestor's filing of a Notice of Appeal and a Request for Continued Examination, along with the appropriate petitions for extension of time, was the diligence required to avoid abandonment of the application after a Final rejection is issued.

The request for resetting of time for response is **DENIED**.

The additional request for refund of fees is moot in view of the above denial. Moreover, the request for refund does not meet the requirements of 37 CFR 1.26 or MPEP 607.02.

This application is currently awaiting action by the examiner after the filing of an amendment on June 21, 2004. An Office action will be mailed in due course.



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